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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/659,262      | 09/11/2003  | Takahiro Moro        | 00862.001703.2      | 3540             |

5514 7590 11/12/2004

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NEW YORK, NY 10112

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| EXAMINER |
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POON, KING Y

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2624

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/659,262             | MORO ET AL.         |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | King Y. Poon           | 2624                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 59-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 59-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 08/768,579.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/11/2003</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 60-62, 67-69, 73-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 60, 67, 73: Claims 60, 67, 72 are claiming "change the set value of the second setting item displayed in the setting window into the fourth value from the third value in response to an operation made by a user if determined to be desirable to change the third value of the second setting item in accordance with the second value of the first item, for printing." Claim 60 depends on claim 59. Claim 59, which is part of claim 60, is claiming "change the set value of the second setting item displayed in the setting window into a fourth value from a third value without any operation made by a user if determined to be desirable to change the third value of the second setting item in accordance with the second value of the first item, for printing." Since both limitations can not be exist together; the applicant fail to particularly point out and distinctly claim whether "change the set value of the second setting item displayed in the setting window into the fourth value from the third value in response to an

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operation made by a user if determined to be desirable to change the third value of the second setting item in accordance with the second value of the first item, for printing" is part of claim 60 or "change the set value of the second setting item displayed in the setting window into a fourth value from a third value without any operation made by a user if determined to be desirable to change the third value of the second setting item in accordance with the second value of the first item, for printing" is part of claim 60.

Regarding claims 61, 62, 68, 69, 74, 75: Claims 61, 62, 68, 69, 74, 75 are rejected under 35 U.S.C. 112, second paragraph, because they depends on rejected claims 60, 67, 72.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 59, 63-66, 70-72, 76, 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto et al (US 5,006,895).

Regarding claims 59, 66, 72: Hashimoto teaches an information processing apparatus (host computer with a input matrix, decoder and a display, column 7, lines 20-30) connected (fig. 5) with a printing device, (column 7, lines 30-45) comprising: a display unit (e.g., fig. 3) adapted to display a setting window including a set value (e.g., selecting a book size/scanning size, column 9, lines 1-10) of a first setting item (book

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size/scanning size) for printing (the scan size determines what is being printed) and a set value of a second setting item (selected size of paper, column 6, lines 18-24) for printing; and a first changing unit (the program of fig. 8A, and 8B) adapted to, when the set value of the first setting item displayed in the setting window is changed into a second value from a first value (e.g., from a B5 to a A5, column 9, lines 1-15, also see fig. 8A and fig. 8B repeat itself), change the set value (S29, fig. 8B) of the second setting item displayed in the setting window into a fourth value from a third value (from fig. 8A and 8B, if the book size changes and the magnification stays the same, most suitable paper size changes) without any operation made by a user (fig. 8A and fig. 8B are programs/routine of the host computer, column 8, lines 45-46) if determined to be desirable (most suitable, fig. 8B) to change (also see changed, column 11, line 39) the third value of the second setting item in accordance with the second value of the first item, for printing.

Regarding claim 63: Hashimoto teaches the information processing apparatus comprising a host computer (column 7, line 24).

Regarding claims 64, 70: Hashimoto teaches wherein the first setting item and the second setting item include a setting of the printing device (column 7, lines 30-45).

Regarding claims 65, 71: Hashimoto teaches wherein the first setting item includes a setting for a medium (scanning medium, original, column 9, lines 1-10) and the second setting item includes a setting for a printing method (using a particular paper for printing, S29, fig. 8B).

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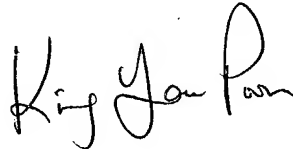
Regarding claims 72, 76, 77: Claim 72, 76, 77 are claiming a computer readable medium for storing a program code for the system and method discussed in claims 59, 64, 65, 66, 70, 71. Hashimoto teaches the invention of claims 59, 64, 65, 66, 70, 71 are written in a program (column 10, line 58; also see routine of column 8, lines 45-46).

Inherently, all program codes are stored in a computer readable memory.

**Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892

10/26/04

A handwritten signature in black ink, appearing to read "King Y. Poon". The signature is fluid and cursive, with the first and last names being more prominent than the middle initial.

KING Y. POON  
PRIMARY EXAMINER